REMARKS

Applicant confirms the Examiner's assumption that claims 58-60 should be dependent on claim 57 and has now amended claims 58-60 to be dependent on claim 57. Applicant respectfully requests that this amendment be entered.

As stated in the January 20, 2005 Amendment, Applicant amended claims 35 and 54 to state that the stabilizing rib is "directly under" the channel. Applicant also added two additional claim sets. Claims 61-86 state that the stabilizing rib is "directly under" the channel. Claims 87-112 state that the stabilizing rib is "on the same radius" as the channel. These amendments were discussed with the Examiner and it was the understanding of the undersigned that these amendments would be allowed subject to a new search. The April 7, 2005 Office Action provides new grounds of rejection based on German reference DE 2 248 441.

Applicant has further amended the further claims to recite that the stabilizing rib is "integral with the elongate polymeric tube" as supported on page 6, lines 17-20 of the application. Applicant respectfully requests entry of this amendment and respectfully submits that the claims as presented are patentable over the cited references.

The claims of the present application stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Sherlock (U.S. Patent No. 3,367,370), Pelzer (U.S. Patent No. 5,212,349) and Bergemann (German reference DE 2 248 441), either alone or in combination with other references. In particular, Sherlock, Pelzer and Bergemann have been combined with one or more of the Pyramid Industries advertisement ("Pyramid"), Craton (U.S. Patent No. 6,139,957), Tzeng (U.S. Patent No. 6,005,191), Levingston (U.S. Patent No. 6,105,649), Karl (U.S. Patent No. 6,135,159), Bird (U.S. Patent No. 6,131,265), Nakamura (JP 05106779A), and Wood (U.S. Patent No. 4,109,941).

The Office Action states that Sherlock discloses a toneable conduit but acknowledges that Sherlock fails to disclose a channel within the wall of the polymeric tube, a stabilizing rib extending longitudinally along the interior surface of the wall and located radially inward from said channel, and a continuous high elongation wire capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube to allow the conduit and wire to be coupled. The Office Action argues, however,

that Pelzer teaches a channel 18 within the wall 16 of the polymeric tube 12 and that Figure 1 of Bergemann teaches a stabilizing rib extending longitudinally along the interior surface of the wall of the elongate polymeric tube and located radially inward from the channel.

Sherlock discloses a plastic pipe construction having metallic material of relatively high electrical or electronic conductivity and sensitivity secured to the pipe body that allows the pipe to be located underground. See Abstract of the Disclosure.

Pelzer discloses a method of inserting a detector wire into a cable duct by making a wire-receiving groove in a wall of the duct, laying the wire in the receiving groove, and leading a separate, softened filler material into the receiving groove and welding it to the duct wall to embed the detector wire in the duct wall. See Abstract of the Disclosure.

Bergemann discloses plastic pipe having a metallic wire conductor embedded therein for purposes of locating the pipe after installation. Bergemann also teaches embedding the conductor in a bead located either inward or outward of the pipe (Figures 1 and 2, respectively) or embedded in the pipe itself (Figure 3).

The combination of Sherlock, Pelzer and Bergemann does not teach or suggest the claimed invention. As acknowledged by the Examiner, Sherlock and Pelzer do not disclose a stabilizing rib extending longitudinally along the interior surface of the wall, located radially inward from said channel, and integral with said elongate polymeric tube. Bergemann also fails to provide this teaching.

Bergemann provides basically three embodiments: a conductor embedded in a bead located inward of the pipe (Figure 1), a conductor embedded in a bead located outward of the pipe (Figure 2), and a conductor embedded in the wall of the plastic pipe. In the first two embodiments, Bergemann specially discloses embedding the conductor in a bead, not in the pipe itself. The bead is not integral with the plastic pipe of Bergemann but separate from the plastic pipe. Thus, to the extent Bergemann discloses a stabilizing rib, Bergemann does not disclose or suggest a stabilizing rib integral with said elongate polymeric tube. The embodiment illustrated in Figure 3 of Bergemann also fails to teach or suggest this element of the present claims but instead discloses a conductor embedded in the wall of the plastic pipe without the use of

stabilizing rib. Accordingly, the present claims are not obvious in view of the combination of Sherlock, Pelzer and Bergemann.

The additional references cited in the Office Action (Pyramid, Craton, Tzeng, Levingston, Karl, Bird, Nakamura and Wood) also fail to teach or suggest a stabilizing rib integral with said elongate polymeric tube. Thus, these references fail to overcome the deficiencies of the combination of Sherlock, Pelzer and Bergemann.

The combination of Sherlock, Pelzer and Bergemann fail to teach or suggest a wire that is capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube and remaining continuous to allow the conduit and wire to be coupled. For example, Sherlock, Pelzer and Bergemann each fail to disclose or suggest tearing a wire out of the polymeric tube to allow it to be coupled. The other references cited in the Office Action also fail to provide this teaching.

It is noted that the Office has argued that the language "capable of transmitting a toning signal to allow the conduit to be detected by toning equipment and capable of being torn out of the polymeric tube and remaining continuous to allow the conduit and wire to be coupled" does not constitute a claim limitation and cites In re Hutchinson to support this position (a copy of which is attached). In Hutchinson, the CCPA stated without explanation that the claim language "an article of manufacture, adapted for use in the fabrication of a metal template of the like suitable for metal-working operations" in the preamble of a claim did not constitute a limitation in a claim. The claim language "adapted for use" in Hutchinson is different than the "capable of" language of the present claims. In particular, "adapted for use," particularly when in the preamble of a claim as it was used in Hutchinson describes an intended use whereas "capable of" as used in the present claims describes a particular property. The phrase "capable of" has been used in other claims and interpreted by the Federal Circuit to be a claim limitation. See, e.g., Plant Genetic Systems, N.V. v. DeKalb Genetics Corp., 315 F.3d 1335, 65 U.S.P.Q.2d 1452 (Fed.Cir. 2003). Accordingly, Applicants respectfully submit that the phrase "capable of" can be used to provide a claim limitation as it has in the present claims and that Hutchinson is not applicable to the present case.

Applicants respectfully submit that all the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. If any minor informalities need to be addressed, the Examiner is directed to contact the undersigned attorney by telephone to facilitate prosecution of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

Andrew T. Meunier
Registration No. 40,726

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Atlanta Office (404) 881-7000
Fax Atlanta Office (404) 881-7777

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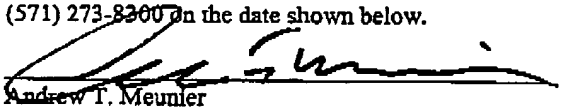

Andrew T. Meunier

October 7, 2005
Date